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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|---------------------|
| 08/447,496 | 05/23/95 | HARVEY | J 5534.121 |

26M2/1209

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WASHINGTON DC 20004

| EXAMINER | |
|----------|--------------|
| MOE, A | |
| ART UNIT | PAPER NUMBER |
| 2604 | 10 |

DATE MAILED: 12/09/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

SEE ATTACHED

Office Action Summary

Application No.

08/447,496

Applicant(s)

Harvey et al

Examiner

Jim Groody

Group Art Unit

2611



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. This action is in response to the amendment filed December 7, 1995.

2. This action will not attempt to determine the effective filing date of this application. The action will apply art against the claims using two possible effective filing dates, i.e. serial number 06/317,510, filed November 3, 1981, and serial number 07/096,096, filed September 11, 1987. Applicants can overcome the art rejections by establishing that the art applied does not meet the claimed limitations or that the art does not have an early enough filing date.

The action will make initial double patenting rejections presuming that all of the present claims were fully disclosed in both the '81 and '87 cases.

In any rejections made under 35 USC 112, first paragraph, applicants will be asked to clarify, where required by the examiner, how the present claims are fully disclosed in both the '81 and '87 cases.

3. Applicants are reminded of their duty to maintain a line of patentable demarcation between related applications. It has been noted by the PTO that many of the pending applications have similar claimed subject matter. In the related 327 applications

(the serial numbers are included in a list below), it is estimated that there may be between 10,000 and 20,000 claims. Applicants should insure that substantially duplicate claims do not appear in different cases, and should bring to the PTO's attention instances where similar claims have been treated inconsistently, i.e. rejected in one case but not in another.

4. Applicants are cautioned that their continual use of alternatives in the claims raises questions concerning the exact claim meaning. More importantly, it raises questions whether the disclosure supports every possible embodiment or permutation that can be created by the alternative language.

5. Claims 4-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are instances when a limitation is claimed either in the preamble or the body of the claim, and then, again later in the claims, without being prefaced by "the" or "said". Applicants should confirm whether the same limitation is being claimed the second time:

claim 4, line 2, "a benefit",

claim 5, line 12, "one or more remote stations",

claim 6, line 13, "an instruct signal", line 14, "a transmitter",

claim 9, line 15, "a transmitter",

claim 12, line 2, "a receiver" and "a transmitter", line 6, "a signal", line 7, "a transmitter", line 9, "a signal", line 11, "a signal", line 13, "a signal",

claim 13, line 2, "a transmitter", line 4, "a signal", line 6, "a signal", line 7, "one or more signals", line 11, "a signal",

claim 16, line 3, "a signal",

claim 17, line 18, "a receiver".

In claim 5, line 7, there is no antecedent for "processing".

Applicants should review claim 12, 13, and 16. The recitation of "signal" or "signals" is unclear since previously other signals were recited. Which signal(s) are these? The claims should be referenced to the drawings.

The remaining claims 7-8, 10-11 and 14-15 are dependent on the rejected based claims 6 and 9, therefore inherit the deficiencies thereof.

6. Claim 17 is rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The '87 case did not disclose the terms "prompting" or "promoting". What do they mean as used in the claims? And why would this usage not be new matter?

7. The following common phrases were not disclosed in the '81 case. It is questioned where, in the '81 disclosure, is there support for an operational embodiment using the established meaning of these terms:

- product
- investment
- value
- taste
- benefit
- income

8. The double patenting rejections in this action are based on the premise that all of the present claims were fully disclosed in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414. Since there was a restriction made in 5,233,654, there will be no double patenting made on that patent or 5,335,277.

9. The PTO's copies of the parent files are in poor form since they have been copied many time by members of the public. The files also are missing some of the papers. The double patenting rejections below presumes that there were no requirements for restriction made in any of the parent files.

10. There are three types of double patenting rejections:

- a) Statutory double patenting rejection under 35 USC 101,
- b) Nonstatutory obvious type double patenting,
- c) Nonstatutory non-obviousness type double patenting.

In this action, the rejections of the third type that are directed to the claims of the parent patented files will have two different versions. The first rejects the claims because they have not been established to be independent and distinct from the patented claims. The second version includes that premise, and further supports the rejection by establishing that representative claims from this application have common subject matter with representative ones of the patented claims.

11. Claims 2-18 (all of the claims in this application) are rejected under the judicially created doctrine of non-obviousness non-statutory double patenting over the patented claims in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414 since the claims, if allowed, would improperly extend the "right to exclude" already granted in those patents.

The subject matter claimed in the instant application is fully disclosed in the patents and is covered by the patents since the patents and the application are claiming common subject matter, as follows: a signal processing apparatus and method including an interactive communications system apparatus and method. Furthermore, there is no apparent reason why applicants were prevented from presenting claims corresponding to those of

the instant application during prosecution of the parent applications which matured into patents. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

A review of the claims in each of the four parent patents (5,109,414; 4,964,825; 4,704,725; 4,694,490) was made. These patented claims do not appear "independent and distinct" from the claims in this application. The present claims are directed to a method and apparatus for controlling communications including television communications or programming. The claims in patent 5,109,414 were directed to a processing system and method for signal distribution including television. The claims in patent 4,965,825 were directed to a system and process for signal processing including carrier communications. The claims in patent 4,704,725 were directed to a method of communicating data to receiver stations. The claims in patent 4,694,490 were directed to a method for communicating and processing television programs.

Applicants' invention can be envisioned at in three parts. As with most cable TV systems, there is a head end station which generates the video programming. Applicants have included an intermediate station which receives transmissions, from the head end or subscriber stations, and distributes the programming to each subscriber. The subscriber station receives the programming, and can communicate to the intermediate station with requests or instructions. Even if the claims directed to each

station were "independent and distinct" from the claims directed to the other stations, there would be no reason to "restrict" between the three stations since their overall function is so interrelated that the stations have the same search area, i.e the PTO could not establish a burden if required to search for all three stations.

It is believed that CCPA in *Schneller* used the "independent and distinct" standard as the main factor in its determination that the double patenting rejection should be affirmed. The CCPA stated that the fundamental reason supporting the principle of non-statutory double patenting rejections is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about. Further the CCPA stated at 158 USPQ 210 (214):

"... To conform to this reason and to prevail here, appellant has the burden of establishing that the invention in his patent is "independent and distinct" from the invention of the appealed claims. The public policy considerations underlying 35 U.S.C. 121 permit separate patents on "independent and distinct" inventions which are initially "claimed in one application." The statute places initial responsibility for this determination on the Commissioner of Patents. Where, as here, no such determination has been made, it is necessary to scrutinize carefully an applicant's voluntary alleged determination of this issue for it can lead to the improper proliferation of patents on the same invention with the inherent result of extending timewise a patentee's right to exclude others from the invention disclosed in the original application and on which his patent has issued."

The CCPA further stated at page 215 the length of time between an earlier patent and a later filed application should be considered. The filing date of this application was over seven

years after the first patent issued (serial number 06/317,510, filed November 3, 1981, patented as 4,694,490 on September 15, 1987) and over four years after the first CIP issued as a patent (serial number 07/096,096, filed September 11, 1987, patented as 4,965,825 on October 23, 1990).

To the extent that one would view *Schneller* and *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) to be in conflict, it is clear that *Schneller* is the controlling precedent to the factual situation here. In *Schneller*, the Court specifically distinguished a situation of the same applicant from one where the application and patent had different inventive entities. In *Kaplan*, the inventive entities between the patent and application were different, as was required at the time of the Kaplan invention, since Kaplan's filing date was before the Patent Law Amendments Act of 1984. In this present case, as with *Schneller*, the inventive entities of the application and patent are the same. Clearly, Kaplan was required, or entitled, to file separate applications, whereas applicants and *Schneller* did not have reason to do so. Finally, decisions of a three-judge panel of the Federal Circuit cannot overturn prior precedential decisions of the CCPA. See *UMC Elec. Co. v. United States* 2 USPQ2d 1465.

12. Claims 2-18 (all of the claims in this application) are rejected under the judicially created doctrine of non-obviousness

non-statutory double patenting over the patented claims in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414 since the claims, if allowed, would improperly extend the "right to exclude" already granted in those patents.

This rejection incorporates the rejection above. That double patenting rejection is further supported by *Schneller* because the great majority of the patented claims are "comprising" type claims.¹ While it is recognized that the specific claim limitations in the application may not have been claimed in the patents, that alone does not establish grounds for overcoming this rejection. The patent claims were directed to parts of applicants' total disclosed system or process. Therefore the recitation of "comprising" enables those patented claims to "cover" claim features now recited by applicants' present application claims.

Since the head end, intermediate, and subscriber stations are part of the overall system, claims to one part "cover" the other part(s) under the *Schneller* decision (page 215), since the preferred embodiment would include all three parts of the main system, i.e. head, intermediate, and subscriber stations. For example, claims to the subscriber station still cover the intermediate station because the subscriber station would be

¹The claims that recite neither "comprising" nor "consisting" are considered to recite open claim language, i.e. equivalent to "comprising". See, for example, claim 1 of Patent 5,109,414.

processing information that had to come from the intermediate station. A second example would be that claims to one aspect or function of the intermediate station would cover the invention of another aspect or function of the intermediate station since both functions could be performed with the other. Applicants' disclosed system includes similar features in the head, intermediate, and subscriber stations. For example, the stations can transmit and receive, and have computer, processor and controller capabilities. For that reason, the disclosure will permit broadly drafted claims to read on either the head, intermediate, or subscriber station. Patent claims that recite receiving and transmitting can cover both intermediate and subscriber stations. The fact that patent claims and application claims are directed to different elements does not prohibit this rejection if there is common or interrelated subject matter recited. The Court in *Schneller* stated at page 215:

"... They "cover" the preferred form ABCXY, common to the patent and this application, in the same sense. The fact that X and Y are distinct elements, performing, independent functions, so that either can be employed without the other, does not change this fact. Neither does appellant's omission of reference to the lip Y from his patent claims."

Application claim 5 is a representative claim. It is directed to a method of communicating to remote stations by storing subscriber data, receiving instruct signals, generating subscriber specific data, receiving viewer's reaction, and transferring subscriber specific data to the remote stations.

A review of representative ones of the patented claims will demonstrate that the patented claims cover the invention claimed in this application:

a) In patent 4,694,490, claim 7 is representative of the claimed method for communicating TV program information to a receiver station. The receiver station receives the video data, displays it, detects the presence of overlay information using an instruct signal, and has computers generate and transmit this overlay info to the display.

b) In patent 4,704,725, claim 3 is representative, and, as summarized below, recites a method of communicating data comprising:

- a) multiple receivers, each with a computer,
- b) transmitting instruct to transmit signals to the computers,
- c) detecting the signals and coupling them to the selected computers,
- d) having the computers control their own selected output device.

c) In patent 4,965,825, claim 24 is representative, and, as summarized below, recites generating a computer output having the steps of:

- a) having multiple receivers, each with a computer,
- b) transmitting an instruct to generate signal to the computers,
- c) causing the computers to generate individual user output information.

d) In patent 5,109,414, claim 15 is representative, and, as summarized below, recites a signal processing system (including):

- a) receiver/distribution means,
- b) switch means,
- c) control signal detector means for transferring data to storage means,
- d) storage means for storing and transferring data to processor means,
- e) processor means for controlling.

While claim 15 is an apparatus claim, a method claim and apparatus claim do not in themselves establish groups that are "independent and distinct".

The patented claims are also primarily directed to methods or structure to control element(s) either directly at that station or at another remote station. This control is generally completed with the reception or recognition of an instruct signal. The same common concept exists in application claim 5. All of the claims, both patented and pending in this application, when considered together, effectively recite parts of the preferred embodiment, i.e. a head, intermediate, and subscriber station. The patented claims "cover" the claims of the application because the patented limitations do not exclude the limitations of this application.

In the arguments above, the examiner, when discussing several of the patents, stated that the patented claims were broad enough to read on multiple stations. While it is believed this analysis is correct, it is not critical to this rejection. Since the patented claims recite limitations that are interrelated with other similar features claimed in this application, it is the examiner's position that those patented

claims "cover" the application claims because all of these claimed features (both in the patent and application) describe what is effectively the preferred embodiment.

The claims in this application, if allowed without a terminal disclaimer, would continue patent protection of the preferred embodiment, i.e. the complete system of the head, intermediate, and subscriber stations, beyond the expiration of applicants' parent patents.

13. A determination of a possible non-statutory double patenting rejection obvious-type in each of the related 327 applications over each other will be deferred until a later time. This action is taken in view of the possibility that many of these applications may be abandoned or merged.

14. Claims 2-16 are rejected under the judicially created doctrine of double patenting over the claims of copending U.S. application 08/113,329 and the following related U.S. applications (all of the applications are series 08):

Serial Number: 447,496
Art Unit: 2611

-15-

| # | Ser. No. | # | Ser. No. | # | Ser. No. |
|-----|----------|-----|----------|-----|----------|
| 1 | 397371 | 2 | 397582 | 3 | 397636 |
| 4 | 435757 | 5 | 435758 | 6 | 437044 |
| 7 | 437045 | 8 | 437629 | 9 | 437635 |
| 10 | 437791 | 11 | 437819 | 12 | 437864 |
| 13 | 437887 | 14 | 437937 | 15 | 438011 |
| 16 | 438206 | 17 | 438216 | 18 | 438659 |
| 19 | 439668 | 20 | 439670 | 21 | 440657 |
| 22 | 440837 | 23 | 441027 | 24 | 441033 |
| 25 | 441575 | 26 | 441577 | 27 | 441701 |
| 28 | 441749 | 29 | 441821 | 30 | 441880 |
| 31 | 441942 | 32 | 441996 | 33 | 442165 |
| 34 | 442327 | 35 | 442335 | 36 | 442369 |
| 37 | 442383 | 38 | 442505 | 39 | 442507 |
| 40 | 444643 | 41 | 444756 | 42 | 444757 |
| 43 | 444758 | 44 | 444781 | 45 | 444786 |
| 46 | 444787 | 47 | 444788 | 48 | 444887 |
| 49 | 445045 | 50 | 445054 | 51 | 445290 |
| 52 | 445294 | 53 | 445296 | 54 | 445328 |
| 55 | 446123 | 56 | 446124 | 57 | 446429 |
| 58 | 446430 | 59 | 446431 | 60 | 446432 |
| 61 | 446494 | 62 | 446553 | 63 | 446579 |
| 64 | 447380 | 65 | 447414 | 66 | 447415 |
| 67 | 447416 | 68 | 447446 | 69 | 447447 |
| 70 | 447448 | 71 | 447449 | 72 | ***** |
| 73 | 447502 | 74 | 447529 | 75 | 447611 |
| 76 | 447621 | 77 | 447679 | 78 | 447711 |
| 79 | 447712 | 80 | 447724 | 81 | 447726 |
| 82 | 447826 | 83 | 447908 | 84 | 447938 |
| 85 | 447974 | 86 | 447977 | 87 | 448099 |
| 88 | 448116 | 89 | 448141 | 90 | 448143 |
| 91 | 448175 | 92 | 448251 | 93 | 448309 |
| 94 | 448326 | 95 | 448643 | 96 | 448644 |
| 97 | 448662 | 98 | 448667 | 99 | 448794 |
| 100 | 448810 | 101 | 448833 | 102 | 448915 |
| 103 | 448916 | 104 | 448917 | 105 | 448976 |
| 106 | 448977 | 107 | 448978 | 108 | 448979 |
| 109 | 449097 | 110 | 449110 | 111 | 449248 |
| 112 | 449263 | 113 | 449281 | 114 | 449291 |

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| # | Ser. No. | # | Ser. No. | # | Ser. No. |
|-----|----------|-----|----------|-----|----------|
| 115 | 449302 | 116 | 449351 | 117 | 449369 |
| 118 | 449411 | 119 | 449413 | 120 | 449523 |
| 121 | 449530 | 122 | 449531 | 123 | 449532 |
| 124 | 449652 | 125 | 449697 | 126 | 449702 |
| 127 | 449717 | 128 | 449718 | 129 | 449798 |
| 130 | 449800 | 131 | 449829 | 132 | 449867 |
| 133 | 449901 | 134 | 450680 | 135 | 451203 |
| 136 | 451377 | 137 | 451496 | 138 | 451746 |
| 139 | 452395 | 140 | 458566 | 141 | 458699 |
| 142 | 458760 | 143 | 459216 | 144 | 459217 |
| 145 | 459218 | 146 | 459506 | 147 | 459507 |
| 148 | 459521 | 149 | 459522 | 150 | 459788 |
| 151 | 460043 | 152 | 460081 | 153 | 460085 |
| 154 | 460120 | 155 | 460187 | 156 | 460240 |
| 157 | 460256 | 158 | 460274 | 159 | 460387 |
| 160 | 460394 | 161 | 460401 | 162 | 460556 |
| 163 | 460557 | 164 | 460591 | 165 | 460592 |
| 166 | 460634 | 167 | 460642 | 168 | 460668 |
| 169 | 460677 | 170 | 460711 | 171 | 460713 |
| 172 | 460743 | 173 | 460765 | 174 | 460766 |
| 175 | 460770 | 176 | 460793 | 177 | 460817 |
| 178 | 466887 | 179 | 466888 | 180 | 466890 |
| 181 | 466894 | 182 | 467045 | 183 | 467904 |
| 184 | 468044 | 185 | 468323 | 186 | 468324 |
| 187 | 468641 | 188 | 468736 | 189 | 468994 |
| 190 | 469056 | 191 | 469059 | 192 | 469078 |
| 193 | 469103 | 194 | 469106 | 195 | 469107 |
| 196 | 469108 | 197 | 469109 | 198 | 469355 |
| 199 | 469496 | 200 | 469517 | 201 | 469612 |
| 202 | 469623 | 203 | 469624 | 204 | 469626 |
| 205 | 470051 | 206 | 470052 | 207 | 470053 |
| 208 | 470054 | 209 | 470236 | 210 | 470447 |
| 211 | 470448 | 212 | 470476 | 213 | 470570 |
| 214 | 470571 | 215 | 471024 | 216 | 471191 |
| 217 | 471238 | 218 | 471239 | 219 | 471240 |
| 220 | 472066 | 221 | 472399 | 222 | 472462 |
| 223 | 472980 | 224 | 473213 | 225 | 473224 |
| 226 | 473484 | 227 | 473927 | 228 | 473996 |

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| # | Ser. No. | # | Ser. No. | # | Ser. No. |
|-----|----------|-----|----------|-----|----------|
| 229 | 473997 | 230 | 473998 | 231 | 473999 |
| 232 | 474119 | 233 | 474139 | 234 | 474145 |
| 235 | 474146 | 236 | 474147 | 237 | 474496 |
| 238 | 474674 | 239 | 474963 | 240 | 474964 |
| 241 | 475341 | 242 | 475342 | 243 | 477547 |
| 244 | 477564 | 245 | 477570 | 246 | 477660 |
| 247 | 477711 | 248 | 477712 | 249 | 477805 |
| 250 | 477955 | 251 | 478044 | 252 | 478107 |
| 253 | 478544 | 254 | 478633 | 255 | 478767 |
| 256 | 478794 | 257 | 478858 | 258 | 478864 |
| 259 | 478908 | 260 | 479042 | 261 | 479215 |
| 262 | 479216 | 263 | 479217 | 264 | 479374 |
| 265 | 479375 | 266 | 479414 | 267 | 479523 |
| 268 | 479524 | 269 | 479667 | 270 | 480059 |
| 271 | 480060 | 272 | 480383 | 273 | 480392 |
| 274 | 480740 | 275 | 481074 | 276 | 482573 |
| 277 | 482574 | 278 | 482857 | 279 | 483054 |
| 280 | 483169 | 281 | 483174 | 282 | 483269 |
| 283 | 483980 | 284 | 484275 | 285 | 484276 |
| 286 | 484858 | 287 | 484865 | 288 | 485282 |
| 289 | 485283 | 290 | 485507 | 291 | 485775 |
| 292 | 486258 | 293 | 486259 | 294 | 486265 |
| 295 | 486266 | 296 | 486297 | 297 | 487155 |
| 298 | 487397 | 299 | 487408 | 300 | 487410 |
| 301 | 487411 | 302 | 487428 | 303 | 487506 |
| 304 | 487516 | 305 | 487526 | 306 | 487536 |
| 307 | 487546 | 308 | 487556 | 309 | 487565 |
| 310 | 487649 | 311 | 487851 | 312 | 487895 |
| 313 | 487980 | 314 | 487981 | 315 | 487982 |
| 316 | 487984 | 317 | 488032 | 318 | 488058 |
| 319 | 488378 | 320 | 488383 | 321 | 488436 |
| 322 | 488438 | 323 | 488439 | 324 | 488619 |
| 325 | 488620 | 326 | 498002 | 327 | 511491 |

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on that copending applications since the referenced copending applications and the instant application are claiming common subject matter, as follows: a signal processing apparatus and method including an interactive communications system apparatus and method.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

A review of the claims in the related copending applications was made. These claims do not appear independent and distinct from the claims in this application. It is believed that CCPA in *Schneller* used the "independent and distinct" standard as the main factor in its determination that the double patenting rejection should be affirmed. The relevant arguments in the preceding paragraphs in support of this position are incorporated herein.

15. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper

timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

17. Claims 2-4 and 6-17 are rejected under 35 U.S.C. § 102(e) as being anticipated by Campbell et al. (US 4,536,791).

Regarding claim 2, Campbell et al. discloses a method of processing signals at a receiver station (11) based on one or more broadcast or cable cast transmissions including: the step of receiving some information content (text sources, Fig. 1) and control signal (control sources, Fig. 1) in said one or more broadcast or cablecast transmissions, said information content describing a service (array of programming choices and other services , such as shopping, and banking, col. 1, lines 20-30); the step of generating a benefit datum (such as stock datum) by processing subscriber datum (movies, special events, news, consumer programming, community access and religious programming, col. 1, lines 55-68) in response to said control signal; the step of delivering said information content and said benefit datum at an output device (20) at said receiver station; the of inputting a subscriber reaction to said delivered information content and benefit datum (Figs. 10 & 15, col. 17, lines 65-68); and the step of generating a control signal and controlling said receiver station based on said inputted subscriber reaction (Fig. 15, elements 502 and 500).

Regarding claim 3, Campbell et al. further discloses comprising the step of storing said subscriber datum at a computer (50) at said receiver station, said subscriber datum being a financial datum (stock, col. 5, lines 5-50).

Regarding claim 4, Campbell et al. discloses further comprising the step of programming said computer to respond to

said broadcast or cablecast control signal in respect of the benefit (col. 4, lines 64-68, col. 5, lines 1-50).

Regarding claim 6, Campbell et al. discloses a method of controlling a remote intermediate data transmitter station (11) to communicate data to one or more receiver stations (40), with said remote transmitter station including a broadcast or cablecast transmitter for transmitting the one or more signals which are effective at a receiver station to instruct a computer or processor (104), a plurality of selective transmission devices (52 & 53) each operatively connected to said broadcast or cablecast transmitter (20) for communicating a unit of data, a data receiver (12, 100), a control signal detector (112), and a controller or computer capable of controlling one or more of said selective transmission devices (12), and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific instruct signal in response to detected specific control signals, and to deliver at its broadcast or cablecast transmitter one or more instruct signals (col. 5, lines 1-25), said method of communicating comprising the steps of: receiving the instruct signal to be transmitted by the remote intermediate data transmitter station and delivering said instruct signal to the transmitter (20) (Fig. 4, col. 7, lines 40-55), said instruct signal being effective at a receiver station (40) to generate a control signal based on a subscriber reaction to a receiver

specific benefit datum (Fig. 6, col. 8, lines 45-68, col. 12, lines 2-26); receiving one or more control signals which at the remote intermediate data transmitter station operate to control the communication of said instruct signal; and transmitting said one or more control signals to said transmitter before a specific time (Figs. 2 & 15, col. 18, lines 50-68, col. 19, lines 1-16).

Regarding claim 7, Campbell et al. discloses comprising the step of embedding a specific one of said one or more control signals in said instruct signal (Fig. 2, elements 50 and 52).

Regarding claim 8, Campbell et al. discloses wherein said specific time is a scheduled time of transmitting said instruct signal (Figs. 11 & 14, col. 15, lines 15-50, col. 19, lines 1-45)

Regarding claim 9, Campbell et al. discloses a method of controlling at least one of a plurality of receiver stations (40) each of which includes a broadcast or cablecast signal receiver, at least one processor (104), a signal detector, said signal detector adapted to receive signals from a broadcast or cablecast signal (Fig. 6, element 112), and said processor programmed to respond to signals from said detector (Fig. 7, col. 9, lines 60-68), and said method of controlling comprising the steps of: receiving at a broadcast or cablecast transmitter station (11, Fig. 2) an instruct signal which is effective at the receiver station (40) to generate a control signal based on a subscriber reaction to a receiver specific benefit datum (such as stock); transferring said instruct signal from said transmitter station

to a transmitter (Fig. 2, elements 12, 16, 20); receiving one or more control signals at said transmitter station, said control signals identifying at least one specific receiver station in which said instruct signal is addressed (col. 10, lines 1-35); and transferring said one or more control signals from said transmitter station to the transmitter, said transmitter station (11) broadcasting or cablecasting said instruct signal and said one or more control signals to said plurality of receiver stations (40) (Fig. 2, col. 4, lines 24-49).

Regarding claim 10, Campbell et al. discloses wherein said instruct signal or control signal is embedded in the non-visible portion of a television signal (Fig. 2B, col. 9, lines 1-14).

Regarding claim 11, Campbell et al. discloses wherein said one or more control signals identifies two of said plurality of receiver station asynchronously and each of said two receiver station receive and respond to said instruct signal asynchronously (col. 12, lines 1-26).

Regarding claim 12, Campbell et al. discloses wherein a switch communicates signals selectively from a receiver and a memory (524) or recorder to a transmitter (16), said method further comprising one from the group consisting of: determining a specific signal source from which to communicate a signal to a transmitter (16) (Fig. 15, elements 500, 502, col. 19, lines 56-68, col. 20, lines 1-59).

Regarding claim 13, Campbell et al. discloses wherein a controller (500) controls a switch to communicate to a transmitter a selected signal, further comprising one from the group consisting of: inputting to said controller the signal which is effective to control said switch (col. 20, lines 1-59).

Regarding claim 14, Campbell et al. discloses further comprising one from the group consisting of: transmitting a receiver station one or more data that designate a time or a channel of transmission of said instruct signal (col. 15, lines 15-50, col. 16, lines 48-60).

Regarding claim 15, Campbell et al. discloses wherein said one or more control signals further comprises downloadable executable code targeted to said processor at one or more of said plurality of receiver stations (40), said downloadable executable code programming the way or method in which said at least one processor (104) responds to said instruct signal (Fig. 7, col. 9, lines 60-68, col. 10, lines 1-36, col. 11, lines 55-65, col. 12, lines 1-26).

Regarding claim 16, Campbell et al. discloses wherein at least one receiver station is adapted to detect the presence of said control signal or programmed to respond to said instruct signal on the basis of location of the signal in an information transmission, said method further comprising the step of causing at least some of said control signal or instruct signal to be

transmitted in said location (Fig. 6, elements 112 & 134, col. 16, lines 1-60).

Regarding claim 17, Campbell et al. discloses an interactive method for information delivery for use with an interactive mass medium program output apparatus (See abstract) comprising the steps of: outputting a mass medium program that contains or explains at least one receiver specific datum, said interactive mass medium program output apparatus having an input device to receive input from a subscriber (Figs. 2 & 15, col. 1, lines 55-68, col. 22, lines 55-68); prompting said subscriber during said mass medium program for input in respect of said information, said interactive mass medium program output apparatus (11) having an output device (20) for outputting said information (col. 16, lines 48-60); receiving a reply from said subscriber at said input device in response to said step of prompting said subscriber (col. 17, lines 20-68), said interactive mass medium program output apparatus having a transmitter for communicating information to a remote station (40) (col. 8, lines 35-45, col. 10, lines 50-64); communicating said reply to a remote site (40), said interactive mass medium output apparatus (11) and said remote site (40) comprising a network having a plurality of transmitter stations (52, 53) (Figs. 2, 6 & 15, col. 6, lines 5-30); generating or assembling, in said network, a message which is effective at said interactive mass medium program output apparatus (11) to generate a control signal based on a subscriber

reaction to a receiver (40) specific benefit datum (such as stock or emergency alert signal) (col. 17, lines 20-50), said interactive mass medium program output apparatus having a receiver for receiving a signal from a remote station; delivering specific combined medium programming at said output device on the basis of said message (Fig. 11, col. 13, lines 1-68).

18. Claims 5 is rejected under 35 U.S.C. § 102(e) as being anticipated by Saeki et al. (US 4,455,570).

Regarding claim 5, Saeki et al. discloses a method of communicating subscriber station (28) information from a subscriber station (28) to one or more remote stations (1), said method comprising the steps of: storing subscriber data at a subscriber station (Fig. 2A, element 42); receiving at said subscriber station (28) one or more instruct signals which are effective to generate a control signal (by 39) based on a subscriber reaction to receiver specific benefit datum (Fig. 4, col. 7, lines 29-55); generating one or more subscriber specific data, a processing at said subscriber station directed by instructions from said one or more instruct signals (col. 7, lines 1-68); receiving a viewer's reaction to a combined medium output at said subscriber station (a plurality of pictures are output based on the viewer requests, col. 6, lines 5-28); transferring one or more subscriber specific data from said subscriber station (28) to one or more remote stations (1) based

on said step of receiving a viewer's reaction (col. 6, lines 5-55).

19. Claim 18 is rejected under 35 U.S.C. § 102(b) as being anticipated by Block et al. (US 4,225,884).

Regarding claim 18, Block et al. discloses a method of processing signals at a receiver station based on one or more broadcast or cablecast transmissions including: the step of receiving a first control signals(ACC) and one of video (SVID) and audio (SAUID) in said one or more broadcast or cablecast transmissions (Fig. 4, col. 3, lines 25-39); the step of generating information by processing subscriber data in response to said first control signal(RSC)(Fig. 4, element 26); the step of delivering said one of video and audio at an output device at said receiver station (Fig. 4, elements 60 & 62); the step of inputting a subscriber response to said delivered one of video and audio (Fig. 4, elements 26 & 32); the step of generating a second control signal (RSC) based on said inputted subscriber response and said generated information; and the step of controlling said receiver station in accordance with said second control signal (Fig. 4, elements 26 & 32, col. 7, lines 25-65).

20. A series of interviews were held before prosecution began on this application. Unless identified specifically below in this part of the action, these interviews did not address the merits

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of any single application, but rather issues that are appropriate to all of the related "Harvey" applications.

The first interview was held on August 13, 1995. It was a personal interview. Attending were one of the applicants, Mr. Harvey, and his attorneys, Messrs. Scott and Woolston. Representing the PTO were Messrs. Godici, Yusko, Orsino, and Groody. Mr. Harvey and his attorneys were informed that because of the large number of related applications, the examination would be performed by a team of examiners. As of the August 1995 interview there existed a problem with some of the applications being charged large entity fees when applicants believed that small entity status was deserved. The PTO has referred this matter to the Office of Assistant Commissioner of Patents, specifically Hiram Bernstein, a petitions attorney. Mr. Harvey's representatives will attempt to resolve this issue through Mr. Bernstein. At this time all of the related cases had not been received in the Group. No examination was planned until at least late October because the team members were managers, and needed to complete other end of fiscal year assignments and all employee performance ratings. The PTO requested that any amendments to the specification, other than to correct continuing status, be delayed. Mr. Harvey's representatives stated that no other amendments to the specification were actually planned. The PTO's goal will be to attempt to reduce the amount of paper passed between applicant and PTO since the cases are related and very

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difficult to move from cite to cite because of their size. Copies of the prior art only need to be filed once. The PTO will only send newly cited art once. Preliminary amendments are being prepared. The PTO however cautioned that the prosecution of the applications will not be delayed until applicants have filed these amendments. The PTO requested a chart establishing any relationships between cases and what parts of applicants' disclosure related blocks of cases were directed to. It was not, at this time, determined whether this chart would become part of the official file. The PTO planned to research this. It was the PTO's intent to examine related cases simultaneously. The PTO welcomed any claim amendments to include resubmissions of all claims, whether amended or not. Mr. Harvey's representatives were informed that the issue of double patenting was expected to be a major issue.

On November 2, 1995, a telephonic interview was held between Mr. Woolston and Mr. Groody. Mr. Woolston indicated that two prior art statements were being completed, one for cases with a 1987 effective date, the other for cases with a 1981 effective date.

On November 30, 1995, a personal interview was held. Representing applicants were Messrs. Scott, Woolston, and Grabarek. Representing the PTO were Messrs. Yusko, Orsino, and Groody. The content of a simultaneously filed prior art statement was discussed. The PTO's copies of the parent files

are missing the non-U.S. patents cited therein. The PTO requested copies of those prior art documents. Applicants gave the PTO a document showing which cases have already been amended. Since this document merely shows the status of any amended application, it has not been made part of the file record since that paper has no bearing on the merits of any issue before the PTO.

A second interview was held on later on November 30, 1995 between Mr. Scott and Mr. Groody. The sole topic discussed was double patenting. The discussion led to no conclusions on whether a double patenting rejections would be made in these applications.

An interview was held on December 6, 1995 between Mr. Scott and Mr. Groody. The discussion was directed to In re Schneller, 158 USPQ 210 (CCPA) and whether that decision will necessitate a double patenting rejection in any of these cases. Mr Scott was asked whether a terminal disclaimer could be filed in all of the 327 related cases to obviate a possible double patenting rejection in each of these cases over each other. Mr. Scott agreed to consider this.

An interview was held on December 13, 1995 between Mr. Scott and Mr. Groody regarding the terminal disclaimer question above. Mr. Scott proposed filing a terminal disclaimer in about 250 of the 327 cases over each other if the PTO would have each of the about 250 issue within 4 or 6 months of each other. Mr.

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Groody felt that the PTO would be unwilling to suspend prosecution in some cases just to have other related cases issue close to each other. No agreement was reached.

Two interviews were held between Mr. Scott and Mr. Groody on April 2, 1996. Mr. Scott pointed out that, in parent file 5,233,654, there had been a restriction requirement. After reviewing the file, Mr Groody indicated that there would not be a Schneller double patenting rejection made in any case based on parent patent 5,233,654 and 5,335,277. The action recently sent out in 08/113,329 would be changed to reflect this point. Mr. Scott inquired whether a terminal disclaimer, in these applications, would have to be filed for all of the four Harvey patents (4,694,490; 4,704,725; 4,965,825; 5,109,414). Mr. Groody felt that all four should be disclaimed, if applicants elect to take that approach toward overcoming the double patenting rejections, because of the requirement in terminal disclaimers concerning common ownership. Mr. Scott indicated that in parent patent 4,965,825, there had been a multiplicity rejection. Mr. Groody will order the file, but felt that rejection would not overcome the Schneller double patenting rejections since the CCPA did not list this situation as an acceptable reason to file continuing cases. The Court limited it exception to "independent and distinct" claims. Mr. Groody acknowledged that the Board of Appeals may accept the multiplicity argument, but, in the absence

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of case law on this issue, he would still apply the Schneller rejections.

On June 10, 1996, Mr Scott spoke with Mr. Groody on several topics. Related case 08/397,582 has been withdrawn from issue in Group 2200, and a new action will be mailed containing a double patenting rejection under *In re Schneller*. This application will now be examiner in Group 2600. Mr. Scott questioned whether applicants can withdraw the terminal disclaimer made in 397,582. Mr. Groody was unsure of the answer, but later checked with Mr. Orsino, who informed him that MPEP 1490 controlled.

Mr. Groody still believes that 08/113,329 can be expedited at the Board. Mr. Scott can refer to the appeal brief to be filed in that case in responding to any application having a *Schneller* double patenting rejection.

A telephone interview was held on June 12, 1996 between Mr. Thomas Woolston and Marc E. Bookbinder representing the PTO. For S.N. 08/448,116, Mr. Woolston indicated that the supplemental preliminary amendment of Nov. 13, 1995 was incomplete and that a complete version of such would be filed shortly to perfect the submission as originally intended. Mr. Woolston also indicated that he intended to file a second supplemental preliminary amendment in this case bringing the total number of claims to 37.

Mr. Bookbinder indicated that the Group would like to have a complete grouping of applications in a manner that was submitted earlier for only a portion of the total filings. Mr. Woolston

stated that such a grouping was available and that he would forward it to the Group as soon as possible.

Mr. Bookbinder requested that each future amendment filed be accompanied by an electronically readable version thereof. Mr. Woolston stated that he could provide a disk to include one or more amendments made to applications as they were filed.

Mr. Woolston stated that he has reviewed actions that have been mailed and that he takes issue particularly with the double patenting rejections and the way In re Schneller has been applied. Mr. Bookbinder suggested that Mr. Woolston contact Mr. Groody of Group 2600 to discuss the particulars of the double patenting rejections since he was the author of those rejections.

On November 25, 1996, a telephone interview was held between Mr. Scott and Mr. Groody. Mr. Groody informed Mr. Scott that expedited processing at the Board for 113/329 would be arranged by the Office. No action on applicants' part was necessary. Applicants no longer had to submit a listing of related cases, since the examiners did not need that. Finally, 397,582, which has been withdrawn from issue, will be examined over all of the art cited in all of the later filed Harvey cases.

21. The art cited in the information disclosure statements submitted by applicants has been considered. The examiner initialed 1449 forms will be sent in a later action.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Groody whose telephone number is (703) 308-5461.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Andrew Faile
ANDREW FAILE
PRIMARY EXAMINER
GROUP 2600